

## REMARKS

In response to the Examiner's New Ground of Rejection of claims 1 and 3-15 under 35 U.S.C. § 101 identified in the Supplemental Examiner's Answer dated February 20, 2009, Applicants request re-opening of prosecution, entry of the foregoing amendments, and reconsideration in view of the foregoing amendments and following remarks. Applicants submit the claim amendments are supported throughout the originally filed application and that no new matter has been added by way of these amendments.

### **Claim Rejections - 35 U.S.C. § 101**

Claims 1 and 3-15 have been rejected under 35 U.S.C. § 101. In rejecting the claims as being directed to allegedly non-statutory subject matter, the Examiner asserts, "applicant's method steps fail the first prong of the new Federal Circuit decision since the are not tied to a machine and can be performed with the use of a particular machine."

Although Applicants respectfully disagree with the Examiner's assertion that the claims are not directed to statutory subject matter, Applicants have amended the claims to further clarify aspects of the claims and better track practical implementations. Applicants note that independent claim 1, recites, *inter alia*, "receiving for storage in a data storage element and processing in a processor agreement information from a user associated with the party ...." Applicants submit that the claimed language is more than simply a "series of mental steps" that would be excluded as non-statutory subject matter.

Furthermore, even assuming, *in arguendo*, the Applicant's method steps fail the first prong of the Federal Circuit decision, Applicants note there are two 'prongs' to the analysis discussed in *In re Bilski* and that a process may qualify as statutory subject matter **under either prong**. Applicants submit there a second prong, involves analyzing whether a process is 'transformative'. That is a 101 statutory process may be statutory if it positively recites subject matter being transformed.

Applicants respectfully submit that independent claim 1 satisfies both prongs of the *In re Bilski* analysis. As such Applicants request withdrawal of this ground of new rejections.

Should the Examiner disagree, Applicants request clarification as to how allegedly neither prongs of the test are met by the pending process claims.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 1 and 3-19 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Pub No. US 2002/0087534 to Blackman, in view of Pub. No. US 2002/0188539 to Axelrad, and in view of Advanced Perl programming by Sriram Srinivasan in 1997 ("Perl"). Applicants respectfully traverse the rejections and request reconsideration.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants respectfully submit the Examiner has failed to establish at least the first two requirements for a prima facie case of obviousness.

Independent claim 1 recites, *inter alia*:

A processor-implemented method for facilitating generation of an agreement document associated with a financial transaction agreement between a party and a counter-party, comprising:

receiving in a data storage element and processing in a processor agreement information from a user associated with the party the agreement information including:

- (i) a counter-party communication address and
- (ii) information about a financial product associated with the financial transaction agreement... [and]  
evaluating the scope stack via an evaluation engine to produce a result in accordance with a rule...

Applicants respectfully submit that the Examiner has not established the combination of the cited references results in the claimed invention and therefore failed to establish (i) the relevant teachings of the prior art relied upon, as well as (ii) the differences in the claim over the applied references.

The Examiner acknowledges deficiencies in Blackman and Axelrad and turns to Perl to remedy these deficiencies, specifically citing page 3, lines 36-41 (See, Page 8 in the 2/20/2009 supplemental Examiner's answer listing the pending rejections). Applicants respectfully submit that Perl's discussion of scope stack, which "is used to remember positions along the save stack that correspond to different scopes..." (Perl, page 3, lines 36-41) would not render the claimed elements obvious to one of ordinary skill in the art at the time of the invention within the context of the claim taken as a whole. MPEP § 2106 II C prescribes that, "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." MPEP § 2141.02 I prescribes that "the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (original emphasis).

Accordingly, Applicants submit that the pending rejection has failed to establish a prima facie case of obviousness for at least claim 1, in view of the cited references. Should the Examiner disagree and maintain the rejection, Applicants respectfully request clarification as to how the Perl reference in combination with the other references allegedly renders obvious the claimed elements as asserted.

### **CONCLUSION**

In summary, Applicants submit that the pending rejection has failed to establish a prima facie case of obviousness for at least claim 1, in view of the cited references. Although of different scope from independent claim 1, Applicants submit independent claim 16 is patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those discussed above. Although of different scope from independent claim 1, Applicants submit independent claim 19 is patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those discussed above. Further, Applicants submit that claims 3-15 and 17-18, which are directly or indirectly dependent on independent claims 1 and 16, respectively are patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those discussed above.

**AUTHORIZATION**

In the event that a telephone conference would facilitate examination of the application in any way, the Examiner is invited to contact the undersigned at the number provided.

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-350CP1. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-350CP1.

Respectfully submitted,

Chadbourne & Parke LLP

Dated: April 20, 2009

By: /Walter G. Hanchuk/  
Walter G. Hanchuk  
Registration No. 35,179

Chadbourne & Parke, L.L.P.  
30 Rockefeller Plaza  
New York, NY 10112  
212-408-5100 Telephone  
212-541-5369 Facsimile